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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

HISASHI YAMAGISHI et al

Application No.: **08/898,853**

Group Art Unit: **3711**

Filed: **July 25, 1997**

Examiner: **Raeann Gorden**

For: **MULTI-PIECE SOLID GOLF BALL**

**RENEWED REQUEST FOR INTERFERENCE PURSUANT TO
37 C.F.R. § 41.202 WITH U.S. PATENT 5,743,816**

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

I. § 41.202(a)(1) - Information Identifying the Patent for Interference

Pursuant to 37 C.F.R. § 41.202, Applicants (hereinafter "Yamagishi et al.") hereby request that an Interference be declared between the above-identified application (hereinafter the "Yamagishi Application") and U.S. Patent 5,743,816, issued to Ohsumi et al., on April 28, 1998, from U.S. Patent Application Serial No. 08/835,023, filed March 27, 1997 (hereinafter the "Ohsumi Patent").^{1/}

The remaining requirements of 37 C.F.R. § 41.202 are met as set forth below.

^{1/} A copy of the Ohsumi Patent was provided to the Examiner along with the "Amendment under 37 C.F.R. § 1.116", filed April 27, 1999.



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II. § 41.202(a)(2) - Proposed Count for the Interference

Interfering Claims

Applicants believe that claims 13-19 of the Yamagishi Application interfere with claims 1-7 of the Ohsumi patent.

Proposed Count

Yamagishi et al. propose the following Count be established in the Interference:

First Alternative

A golf ball according to any of Claims 1-7 of the Ohsumi Patent

or

Second Alternative

A golf ball according to any of Claims 13-19 of the Yamagishi Application.

Claims 1-7 of the Ohsumi Patent and Claims 13-19 of the Yamagishi Application are identical to first and second alternatives, respectively, of the proposed Count. Further, claims 1-7 of the Ohsumi Patent relate to claims 13-19 of the Yamagishi Application, respectively. See Appendix A.

III. Claim Comparison §41.202(a)(3)

A. The Yamagishi Application

In any Interference declared between the Yamagishi Application and the Ohsumi Patent, Claims 13-19 of the Yamagishi Application, directed to a multi-piece solid golf ball, should be designated as corresponding to the proposed Count.

The Yamagishi Application is directed to a multi-piece solid golf ball having a structure of at least four layers, as shown in Figure 2. The golf ball includes a core having a structure

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including at least two layers, referred to in the disclosure as an inner sphere 12 and layer 13 that surrounds the inner sphere 12, and a cover for enclosing the core. The cover has an inner cover layer 15 and outer cover layer 16. The outer cover layer 16 has a hardness in the range of 40 to 60 Shore D, and the inner cover layer has a hardness of up to 53 Shore D and is lower than the hardness of the outer layer 16.

Similarly, the Ohsumi Patent discloses and claims a four-piece (“multi-piece”), solid golf ball having a core including an inner layer 12a, intermediate layer 12b, outer layer 12c, and a cover 14 for covering the core, as seen in the lone figure of the Ohsumi Patent. As disclosed in the Ohsumi patent, the Shore D hardness of the layers 12a and 12b fall within the range of 15-40 and 45-65, respectively, while the Shore D hardness of the layer 12c is less than the layer 12b and is less than the cover 14, which has a hardness of 68 Shore D.

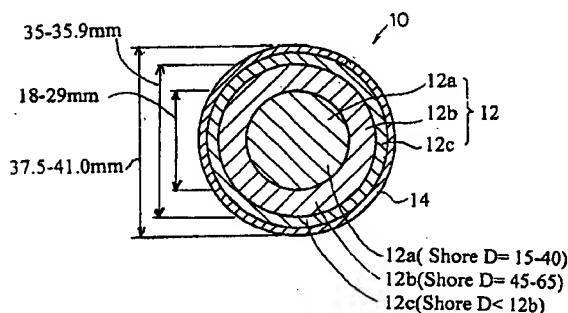
The layers of the golf ball disclosed and claimed in the Ohsumi Patent corresponds to the layers of the golf ball disclosed and claimed in the Yamagishi Application as follows:

Ohsumi Patent	Yamagishi Application
Inner layer 12a	Inner sphere 12
Intermediate layer 12b	Layer 13
Outer layer 12c	Inner cover layer 15
Cover 14	Outer cover layer 16

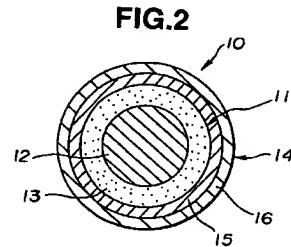
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For ease of reference, the relevant figures from the Ohsumi Patent (left) and the Yamagishi Application (right) are reproduced below.



Ohsumi Patent



Yamagishi Application

The Ohsumi Patent characterizes the layers 12a, 12b, 12c as part of the core, and refers to the core as composed of a three-layered structure. Ohsumi Patent, col. 2:30-33; 2:37-38; 2:48-50. On the other hand, the Yamagishi Application refers to the core as including two layers 12, 13 and the cover as including two layers 15, 16. Applicants submit that there is no difference in the layer 12c of the Ohsumi Patent, which is characterized as part of the core, and the inner cover layer 15 of the Yamagishi Application, which is characterized as part of the cover. Both layers are the third layer counting from inside out and, conversely, both layers are the second layers counting from outside in.

Moreover, both layers may be composed of similar materials such as an ionomer resin,² as opposed to a rubber base material which is the typical composition of a core layer. Both layers have similar compositions. For example, the Ohsumi Patent states that the layers making

² Compare Ohsumi Patent, col. 2:48-55 and Table 1, Example 5 with Yamagishi Application, page 6, lines 26-29.

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up the core may be formed of a rubber composition composed of a base material of natural and/or synthetic rubber, or may be formed using a material comprising an ionomer resin and/or a thermoplastic elastomer such as those composed of styrene, olefin, urethane, ester, and amide. The Ohsumi '816 patent, col. 2:48-55. Table 1 lists five examples where the layers of the core vary. In Example 5, the outer layer 12c is composed of a thermoplastic polyamide elastomer and Himilan 1605 (i.e., an ionomer resin). In the Yamagishi Application, the surrounding layer 13 may be formed of an ionomer resin or thermoplastic resin (e.g., Himilan which is an ionomer resin or Hytrel which is a polyester elastomer) (pages 7 and 10) and the inner cover layer 15 may be composed of an ionomer resin. Page 6, lines 26-29.

Claims 13-19 of the Yamagishi Application were copied substantially verbatim from the Ohsumi Patent, claims 1-7. In particular, claims 13 and 16-17 and 19 were copied identically, while claims 14-15 and 18 vary slightly. The range of hardness (claim 14) and diameter (claim 15) of the "inner layer," and composition of one of the inner layers (claim 18) are slightly different so that the copied claims are supported by the disclosure of the Yamagishi Application. These differences are insubstantial. The hardness described in the Yamagishi Application ranges from 20 to 40, while in Ohsumi Patent the hardness ranges from 15 to 40. The diameter of the inner layer is defined in the Yamagishi Application as ranging from 20 mm to 39 mm, while in Ohsumi Patent the diameter ranges from 18 to 29 mm. The composition of the surrounding layer 13 (i.e., one of the layers of the "core") may be of an ionomer resin or thermoplastic resin. Specific examples include Himilan (an ionomer resin) and Hytrel (a polyester elastomer).

B. The Ohsumi Patent

In any Interference declared between the Yamagishi Application and the Ohsumi Patent, Claims 1-7 of the Ohsumi Patent should be designated as corresponding to the proposed Count, for the same reasons set forth above regarding claims 13-19 of the Yamagishi Application.

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C. Claim Chart

Attached hereto, in Appendix A, is a claim chart placing the claims 13-19 of the Yamagishi Application side-by-side with the corresponding claims 1-7 of the Ohsumi Patent.

IV. § 41.202(a)(4) - Why Yamagishi Should Prevail on Priority

A. The Yamagishi Application has an earlier effective filing date than does the Ohsumi Patent

As noted below, the Yamagishi Application is entitled to an effective filing date of June 14, 1995, whereas at best the Ohsumi Patent would be entitled to an effective filing date of April 1, 1996.

It should be determined that Yamagishi et al's Japanese priority document was filed prior to the March 27, 1997, filing date of the application which matured into the Ohsumi Patent. In particular, Yamagishi et al's Japanese priority document was filed June 14, 1995. This date is prior to the March 27, 1997, filing date of the application which matured into the Ohsumi Patent, as well as prior to the April 1, 1996, filing date of Ohsumi's Japanese priority document.

Accordingly, in any Interference declared between the Yamagishi Application and the Ohsumi Patent, Yamagishi et al should be designated the Senior Party and Ohsumi et al should be designated the Junior Party.

B. The Yamagishi Application

Claims 13-19 of the Yamagishi Application were presented in the Amendment filed April 27, 1999. That is, Claims 13-19 were added to the Yamagishi Application less than one year after the issuance of the Ohsumi Patent on April 28, 1998.

The Yamagishi Application is a Rule 60 Continuation of Yamagishi Parent Application Serial No. 08/661,775, filed June 13, 1996 (now U.S. Patent 5,688,595).

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Yamagishi et al. claim benefit of priority under 35 U.S.C. § 120 to Yamagishi Parent Application Serial No. 08/661,778, filed June 13, 1996.

As discussed in detail in the Preliminary Amendment filed July 25, 1997, the Amendment filed July 25, 1997, and the Amendment filed October 28, 1998, Claims 13-19 are supported in the Yamagishi Application. Claims 13-19 were added subsequent to the original filing. However, support for Claims 13-19 of the Yamagishi Application can be found in Appendix B, attached hereto.

Furthermore, the Yamagishi Application is a Rule 60 Continuation of Yamagishi Parent Application Serial No. 8/661,778, filed June 13, 1996. Thus, identical support for Claims 13-19 can be found in the Yamagishi Parent Application.

Accordingly, in any Interference declared between the Yamagishi Application and the Ohsumi Patent, Claims 13-19 of the Yamagishi Application should be accorded benefit under 35 U.S.C. § 120 to the June 13, 1996, filing date of Yamagishi Parent Application Serial No. 08/661,778.

Furthermore, Yamagishi et al. claim benefit of priority under 35 U.S.C. § 119 to JPA 7-171520, filed June 14, 1995. Support in sworn English translation of JPA 7-171520 for claims 13-19 of the Yamagishi Application can be found in the claim chart in Appendix C, attached hereto.

A certified copy of JPA 7-171520 was filed on June 13, 1996, in the Yamagishi Parent Application. Acknowledgement of receipt of said certified copy of the JPA 7-171520 can be found on page 1 of the Office Action dated May 29, 1998 in the Yamagishi Application. Moreover, on February 29, 2000, with the original Request for Interference, Yamagishi et al. submitted a sworn translation into English of JPA 7-171520.

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Hence, Claims 13-19 of the Yamagishi Application are fully supported, in accordance with 35 U.S.C. § 112, in JPA 7-171520, filed June 14, 1995.

Accordingly, in any Interference declared between the Yamagishi Application and the Ohsumi Patent, Claims 1-19 of the Yamagishi Application should be accorded benefit under 35 U.S.C. § 119 to the June 14, 1995, filing date of JPA 7-171520.

C. The Ohsumi Patent

As discussed above, the filing date of the application which matured into the Ohsumi Patent is March 27, 1997. The Ohsumi Patent does not claim benefit of priority under 35 U.S.C. § 120 to any earlier filed U.S. application.

The Ohsumi Patent claims benefit of priority under 35 U.S.C. § 119 to JPA 8-079203, filed April 1, 1996. However, a sworn translation into English of JPA 8-079203 copy is not of record in the file history of the Ohsumi Patent. Thus, at least at this point in time, Ohsumi et al is not entitled to benefit of priority under 35 U.S.C. § 119.

V. § 41.202(a)(5) - Written Description

Appendix B sets forth a claim chart showing the written description for each of claims 13-19 in the specification as originally filed.

VI. § 41.202(a)(6) - Constructive Reduction to Practice

Appendix C sets forth a claim chart showing where the disclosure provides a constructive reduction to practice, by Applicant's Japanese priority document 07-171520, within the scope of the interfering subject matter. References in the claim chart of Appendix C are made to the Verified English translation of the priority document as filed on February 29, 2000.

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VII. § 41.202(d)(1)

This section does not apply to the current situation.

VIII. Conclusion

The Examiner is invited to contact the undersigned at his Washington telephone number on any questions which might arise.

Respectfully submitted,



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